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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|--|-------------|----------------------|------------------------------|------------------------|
| 10/590,951   | 11/08/2006  | Franz jun. Neuhofer  | NEUHOFFER, JR.-16 PCT        | 3739                   |
| 25889  | 7590        | 08/17/2010           |                              |                        |
| COLLARD & ROE, P.C.<br>1077 NORTHERN BOULEVARD<br>ROSLYN, NY 11576 |             |                      | EXAMINER<br>TRIGGS, ANDREW J |                        |
|  |             |                      | ART UNIT<br>3635             | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>08/17/2010      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/590,951 | <b>Applicant(s)</b><br>NEUHOFER, FRANZ JUN. |  |
|                              | <b>Examiner</b><br>Andrew J. Triggs  | <b>Art Unit</b><br>3635                     |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8 and 10-12 is/are pending in the application.
- 4a) Of the above claim(s) 8 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4, 10 and 12 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Examiner acknowledges the amendments to claims 2-6 and 8, the cancellation of claims 7 and 9 as well as newly added claims 10-12.

### ***Election/Restrictions***

2. Newly submitted claim 11 and amended claim 8 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The previously examined claims were for the device of a profiled cover. The newly submitted invention is for the method of producing the floor covering device

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8 and 11 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 10 and 12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

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had possession of the claimed invention. The following items are not supported by the disclosure:

- a. A first contact surface
- b. A second contact surface
- c. A groove **section**
- d. The first contact surface extending **past** the clamping web
- e. The second contact surface extending **past** the clamping web

***Allowable Subject Matter***

5. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Claim Rejections - 35 USC § 103***

6. Claims 10 and 12 rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent # 6,860,074 to Stanchfield.

Regarding claims 10 and 12, Stanchfield teaches a covering device for joints in panels such as floor panels (Abstract). Stanchfield teaches that the cover can be made of plastic based products, such as PVC (Column 4, Lines 50-51). These types of materials are commonly formed by extruding them through a machine to create the desired profile. Stanchfield teaches, in Figure 2, a clamping web (16) that protrudes downward from the covering flange (12) and extends in a longitudinal direction along the cover. The clamping web (16) is used to secure the cover by inserting it into the clamp (26). Stanchfield also teaches a compensating strip

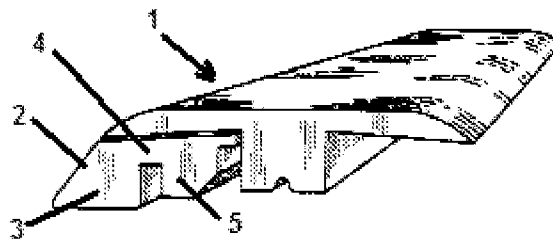
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(40) on the underside of the covering flange that engages the covering flange with a tongue and groove mechanism (18). Stanchfield also teaches, in Figure 2, that the floor covering (12) is flat over the floor (24 and 25) of which it covers. Stanchfield teaches, in Figure 2, that the tongue (18) is on the covering device and the groove (42) is on the compensating strip (40) as seen in Figure 3. Stanchfield discloses the claimed inventions except for the tongue and groove mechanisms are reversed. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the cover with the groove and the compensating strip with the lug, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art *In re Einstein*, 8 USPQ 167. With the reversal of the tongue and groove mechanisms, the cover would be suitable for use without a compensating strip between two floors coverings having the same height. Furthermore, Stanchfield shows in Figure 2, the underside of the cover (12) has two portions, one which would have the groove and the other which would be a flat portion. One side of the cover is resting on a floor (24) without a compensation strip, thus giving the covering flange (12) a contact surface for support on the floor cover segment (24). Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

4. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941.

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Regarding claim 2, Stanchfield teaches a covering device with a compensating strip that has a tongue and groove connecting mechanism but does not teach the compensating strip has two legs. However, Neuhofer teaches in the annotated figure below, a covering device (1) with a compensating strip (2) that has a basic form of an angle and two legs (3 and 4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. Furthermore, it can be seen that the compensating strip (2) makes an extension of the cover (1) extending downward. One of ordinary skill in the art at the time of the invention would have been motivated to have a compensating strip with two legs because the legs form a continuation of the covering device that creates a smooth even flowing cover over a gap between panels. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.



Regarding claim 3, Stanchfield teaches a compensating strip but does not teach a supporting leg connected to the leg that has the tongue and groove mechanism. However, Neuhofer teaches in the annotated figure above, that the compensating strip (2) has a supporting leg (5) projecting from leg (4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. One of ordinary skill in the art at the time of the invention would

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have been motivated to further include a supporting leg because a groove between the supporting leg and other leg can be used to secure the compensating strip securely. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941 in further view of Kemper, US Patent # 6,345,480.

Regarding claim 4, Stanchfield in view of Neuhofer teach a cover device that has a supporting leg on the compensating strip. It can be seen in Figure 1 of Neuhofer that there is a channel between the legs that is capable of accepting a fixture from the profile cover but Stanchfield only teaches one securing means (26) on the fixture. However, Kemper teaches the use of two securing means (6 and 12) on the fixture (3). One of ordinary skill in the art at the time of the invention would have been motivated to include two or more securing means on the floor mounting plate fixture in order to secure not only the covering device but also the compensating strip to the floor. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

### ***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the newly submitted claims. Furthermore, arguments are made toward the case law of *In Re Einstein* which has already been discussed multiple times and the arguments still have not persuaded the Examiner.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Triggs whose telephone number is 571-270-3657. The examiner can normally be reached on Monday through Thursday 6:30am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./  
Supervisory Patent Examiner, Art Unit 3635

/Andrew J Triggs/  
Examiner, Art Unit 3635